



Patent
Attorney's Docket No. 018775-838

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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GROUP 1700

In re Application of)

Toshimitsu FUJIWARA et al)

Application Serial No. 09/928,495)

Filed: August 14, 2001)

For: RECYCLABLE IMAGE-RECORDING)
MEDIUM)

Group Art Unit: 1774

Examiner: M. Grendzynski

Confirmation No. 7913

10/01/2003 SDIRETA1 00000009 024800 09928495

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RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In complete response to the Official Action (Restriction Requirement) mailed on December 24, 2002, in connection with the above-identified application, Applicants elect with traverse, the species set forth in group e of the Official Action. Applicants respectfully consider that claims 11-16 are readable upon the elected species.

Applicants respectfully traverse the requirement for restriction for at least the following reasons.

In accordance with MPEP § 803, an application may be properly restricted to one or more claimed inventions only if (1) the inventions are independent or distinctly claimed, and (2) there is a serious burden on the Examiner if restriction is not required. Thus, even if appropriate reasons exist for requiring restriction, such a requirement should not be made unless there is a serious burden on the Examiner to examine all of the claims in a single application.

In the present case, Applicants respectfully submit that the species identified in the Official Action have a number of the same features in common such that the claims are best examined together in a single application. For example, each of the claims are directed to an image-recording medium comprising a base layer and at least a surface layer comprising a water-swelling resin. Although an intermediate layer may be included, an image may be

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present inside or on the layers, and/or the image-recording medium may have a portion which is not covered with the surface layer, Applicants submit that the presence of the same general features (i.e., a base layer and at least a surface layer comprising a water-swelling resin) warrants a search and examination of all of the claimed features, particularly since the presence of additional features is allowable within the scope of the broader claims. Separation of the additional features claimed from the broader claims in a "species" election simply provides the unnecessary expedient of limiting the number of claims under consideration, rather than advancing the prosecution for Applicants' invention.

Applicants further respectfully submit that the similarities noted above suggests that a serious burden upon the Examiner to search all of the features of the claims does not exist since the broadest features claimed must still be examined.

With regard to the claims readable upon the elected species e, it is noted that claims 13-16 are within the scope of claim 11 since they depend from claim 11. As such, the additional features of claims 13-16 should be examined together with the broader claims (i.e., claims 11-12) at least for the reason that a search of the broader claims must necessarily include a search and examination of the entire scope of the claim, including the dependent claims.

For at least the foregoing reasons, Applicants respectfully request withdrawal of the species election requirement and search and examination of all of the pending claims.

If any issues remain outstanding, or should there be any questions concerning the above remarks or the application, the Examiner is respectfully requested to contact the undersigned at (703) 836-6620.

Respectfully submitted,

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